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Attorney Docket No. P24348

In re application of: Dr. Ing. Rolf van HAAG

Application No. : 10/685,390

Mail Stop Amendment

Group Art Unit : 3726

Filed : October 16, 2003

Examiner : M.Q. JIMENEZ

For : ROLL, IN PARTICULAR MIDDLE ROLL OF A CALENDER, AND CALENDER

Mail Stop Amendment

Commissioner for Patents

U.S. Patent and Trademark Office

Customer Service Window, Mail Stop Amendment

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Sir:

Transmitted herewith is an **Election with Traverse** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ An Information Disclosure Statement, PTO Form 1449, and references cited.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 46	*46	0	x25=	\$	x 50=	\$ 0.00
Indep. Claims: 2	**3	0	x100=	\$	x200=	\$ 0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$ 0.00
Extension Fees for __ Month(s)				\$		\$ 0.00
Total:				\$	Total:	\$ 0.00

* If less than 20, write 20

** If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$ ____.

☐ A check in the amount of \$ ____ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).


 Neil F. Greenblum

Reg. No. 28,394

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Reg. No. 35,043



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dr.-Ing. Rolf van HAAG Confirmation No.: 6679
Appln. No. : 10/685,390 Group Art Unit: 3726
Filed : October 16, 2003 Examiner: M.Q. JIMENEZ
For : ROLL, IN PARTICULAR MIDDLE ROLL OF A CALENDER, AND
CALENDER

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop _____
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's restriction requirement of May 11, 2006, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., June 12, 2006 (June 11, 2006 being a Sunday), Applicant hereby elects, with traverse, the invention of Group I, including claims 1 and 3 – 37. Moreover, Applicant elects, with traverse, species B, which is directed to Figure 3a. Applicant notes claims 1, 3 – 15, 17 – 22, and 34 are readable on the elected species, and at least claim 1 is generic. The above elections are made with traverse for the reasons set herein below:

In the Official Action of May 11, 2006, the Examiner indicated that all claims (1 - 46) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including claims 1 and 3 – 37, drawn to a roll, classified in class 492, subclass 20; Group II, including claims 2, 38, and 39, drawn to a calender,

classified in class 101, subclass 193; and Group III, including claims 40 – 46, drawn to a process, classified in class 101, subclass 35.

The Examiner asserts the inventions of Group I and II are related as mutually exclusive species in an intermediate-final product relationship, and the inventions are distinct from each other under M.P.E.P. § 806.05(j) because the "intermediate product is deemed useful as a stand alone roll without the need to be utilized with additional rolls and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants."

The Examiner also asserts the inventions of Group I and III are related as product and process of use, and the inventions are distinct from each other under M.P.E.P. § 806.05(h) because the "product could be used in a process of guiding something other than a paper web."

Still further, the Examiner asserts the inventions of Group II and III are related as process and apparatus for its practice, and the inventions are distinct from each other under M.P.E.P. § 806.05(e) because the "apparatus could be used to guide something other than a paper web."

Applicants respectfully submit that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged a possible distinction between the two identified groups of invention, the Examiner has not shown that a concurrent examination of

these groups would present a "serious burden." While the Examiner has asserted Group I would be classified in a different classification class than Groups II and III, there is no appropriate statement that the search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Groups II and/or III, and vice versa. Moreover, the Examiner asserts Groups II and III would be classified in the same classification class 101, yet again fails to provide an appropriate statement that the search areas required to examine the invention of Group II would not overlap into the search areas for examining the invention of Group III, and vice versa. Therefore, it appears the search for the combination of features recited in the claims of the above-identified groups of invention, if not totally co-extensive, would appear to have a very substantial degree of overlap.

Because the search for each group and species of invention is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Groups I - III. Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. § 803, Applicant respectfully requests the Examiner reconsider and withdraw the restriction and species requirement in this application.

In addition to the restriction of inventions, the Examiner has required an election of one of the following species:

Species A -- Figure 2;

Species B -- Figure 3a;

Species C -- Figure 3b;

Species D -- Figure 3c;

Species E -- Figures 4 and 5;

Species F -- Figure 6;

Species G -- Figures 7a and 7b;

Species H -- Figure 8;

Species I -- Figure 9; and

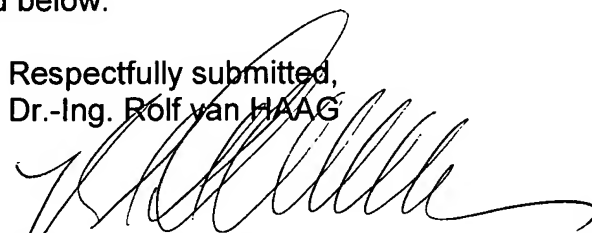
Species J -- Figure 10.

Applicant has elected species B directed to Figure 3a with traverse. Moreover, Applicant acknowledges that, upon allowance of a generic claim, the other species will be rejoined and examined on their merits.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I and species B, i.e., claims 1, 3 – 15, 17 – 22, and 34, in which at least claim 1 is generic, in the event that the Examiner chooses not to reconsider and withdraw the restriction or species requirement.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Dr.-Ing. Rolf van HAAG



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June 12, 2006
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